

## **REMARKS**

### **Claim Rejections**

Claims 2-4 are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements. Claims 2-4 are also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-4, as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Su '675 in view of Dob '012.

### **Amendments to Specification**

Applicant has amended the Specification as noted above to overcome the Examiner's objections thereto. It is believed that the foregoing amendments to the Specification overcome the outstanding objections thereto. In addition, it is believed that, in view of the disclosure on p. 4, ll. 11-16, no amendments to the specification are necessary with regard to the recited "a manual fan speed controlling interface." Support for these amendments can be found in Applicant's Fig. 1 which clearly shows both a fan frame and, also, a central hole in the PCB board (13) which is aligned with the preset hole (15). No "new matter" has, therefore, been added to the original disclosure by the foregoing amendments to the Specification.

### **Claim Amendments**

By this Amendment, Applicant has amended claim 4 of this application to overcome the Examiner's objections thereto, as well as to better protect what Applicant regards as the invention. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The amended claims are directed toward: a cooling fan with a built-in adjustable speed structure, comprising: a fan; a fan frame supporting the fan; a stator frame for supporting a stator of an electric motor powering the fan, the stator frame having a preset hole therein; a PCB board including control electronics, *the*

***PCB board having a central hole aligned with the preset hole***; and a manual fan speed control interface partially extending through the preset hole to connect with a variable resistor and the control electronics.

Su teaches a power supply 1 having a knob 112. However, the knob 112 is clearly shown in Fig. 1 as mounted on the outside of the housing of the power supply 1 in a position spaced apart from the fan 11; this location does not teach or suggest mounting the knob 112 in a preset hole in the stator frame. In addition, Fig. 3 clearly shows that the fan 11 is a conventional cooling fan. As admitted by the Examiner on p. 4 of the prior Office Action, Su fails to teach components integrated on a PCB or that the knob is connected to a variable resistor. Furthermore, as admitted by the Examiner in the outstanding Office Action, Su does not teach a PCB aligned with a preset hole.

Dob et al. is cited as teaching a knob 36 located in a preset hole aligned with a PCB 35. However, it is important to note that the preset hole referred to by the Examiner is a hole in the base 12. In fact, the reference does not teach any sort of hole in the PCB 35 at all, much less a central hole in the PCB aligned with a preset hole in the stator frame (as recited in claim 1, as amended, and shown in Applicant's Fig. 1).

It follows that even if the teachings of Su and Dob et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a cooling fan with a built-in adjustable speed structure, comprising: a fan; a fan frame supporting the fan; a stator frame for supporting a stator of an electric motor powering the fan, the stator frame having a preset hole therein; a PCB board including control electronics, the PCB board having a central hole aligned with the preset hole; and a manual fan speed control interface partially extending through the preset hole to connect with a variable resistor and the control electronics.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over

40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the

teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Su or Dob et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Su nor Dob et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.


**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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